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No. 74-584

In the Supreme Court of the United States

OCTOBER TERM, 1974

MARY HELEN SEARS,
Petitioner,

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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PETITIONERS SUPPLEMENTAL BRIEF PURSUANT TO RULE 24(5)

EDWARD S. IRONS
1801 K Street, N.W.
Washington, D. C.
Attorney for Petitioner

WILSON - EPES PRINTING CO., INC. - RE 7-6002 - WASHINGTON, D. C. 20001

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Question 1 presented by this petition is the same as question 1 in No. 74-450, *Robertson* v. *Butterfield*, now *sub-judice*. Petitioner's various motions to expedite consideration of the petition and to participate in the oral argument of *Robertson* were all denied. Petitioner was relegated to the filing of a brief *amicus curiae*.

The petition in this case should be granted, regardless of the disposition of *Robertson*. Questions 2, 3 and 4 on this petition present issues of constitutional dimension not present in *Robertson*. These issues are of importance in the administration of both the patent laws and the Freedom of Information Act.

1. The statute at issue in this case is § 122 of Title 35. It provides:

> "Applications for patents shall be kept in confidence by the Patent Office . . . *unless necessary to carry out the provisions of an act of Congress. . . .*"

The underlined passage is *unique* to § 122. It is *not* found in the statute specifically before this Court in No. 74-450—or in any of the other statutes considered in their briefs by the parties in that case.

Instead, the unique provision is ignored by both parties, and for essentially the same reason—to permit § 122 to be inappropriately lumped together with a plurality of other statutes for the purpose of construing exemption 3. Significantly, both parties to No. 74-450 *include* § 122 in an artificial class of statutes said to satisfy exemption 3's requirements.

Contrary to this approach, by reason of its unique provision, § 122 is not properly included as a member of either of the artificial classes of statutes suggested by the parties to No. 74-450. Neither in any other statute containing a comparable provision. For these reasons, the decision in No. 74-450 should be carefully drawin. It cannot properly resolve the question of whether any such statute "specifically exempts" within the meaning of § 552(b)(3).

2. Any ruling in No. 74-450 which compromises the unique provisions of § 122 would be erroneous. It would also constitute a serious miscarrriage of justice.[1] It

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[1] It is doubtful that petitioner has been afforded equal access to the Court in this case. Witness the record of petitioner's repeated attempts to be heard concurrently with No. 74-450—all of which were summarily rejected.

Compare the May 28, 1974 order granting each of the petitions in No. 73-1233 and No. 73-1316 and setting those FOIA cases for oral argument in tandem. —— U.S. —— 41 L.Ed. 2d. 211.

[Footnote continued on page 3]

would leave unsettled important issues of patent law which have not been bu tshould be resolved here.

The records sought by petitioner in this case are abandoned patent applications. The court of appeals, adopting an overbroad construction of the exemption 3, held that abandoned patent applications are "specifically exempted from disclosure" by § 122. Accordingly, question 3 on this petition asks:

> "3. Are abandoned applications 'necessary to carry out the provisions of any act of Congress' including 35 U.S.C. §§ 102 and 103 and hence disqualified from secrecy by the very terms of 35 U.S.C. § 122?"

This question was not presented in No. 74-450. It is not before the Court and hence cannot properly or fairly be resolved in that case.

3. The court of appeals answered question 3 in the negative. It thereby raised—but rejected as "immaterial"—serious constitutional issues subsumed in question 4 of this petition. These issues include the fundamental question:

> "Could it possibly be constitutionally insubstantial that the Patent Office, under guise of § 122, has adopted regulations that preclude access to and foreclose the Patent Office from considering a substantial portion of the evidence germane to whether a patent should issue?" [2]

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[1] [Continued]

It is noted that an unusually high percentage of the petitions for certiorari recently granted involve the FOIA. All such granted petitions, however, appear to have been filed by the Department of Justice; none of the several petitions filed by a party *opposing* the Government having been granted.

[2] *Graham* v. *John Deere Co.*, 383 U.S. 1; and *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57, emphasize that the patentability "*standard* expressed in the Constitution . . . may not be ignored." Pet. 3, n. 2.

According to the Patent Office, there are some 600,000 abandoned patent applications. Under the presumed authority of § 122, the Commissioner who is charged with "the primary responsibility for setting out unpatentable material", *Graham supra* 383 U.S. at 18, not only suppresses all of this evidence of the "level of ordinary skill in the pertinent art" *ibid*—the very yardstick by which inventions are measured for compliance with the constitutional patentability standards—but with premeditation has also imposed secrecy to disqualify it as statutory "prior art" under 35 U.S.C. §§ 102(a) and (b) and 103 on the ground that *because* of the agency's rule, the abandoned applications are not "publications" within the meaning of these statutes. Pet. 8.

The net result of this expedient agency practice is the "notorious difference between the standards as applied by the Patent Office and the courts," and the necessity "to await litigation" (where the abandoned applications may be obtained through the discovery process and used as evidence to invalidate an issued patent, see the petition, p. 23, n. 35)—and so "to debilitate the patent system". id. at 18.

The dichotomy between the Patent Office and the courts as to the evidentiary signficance of abandoned patent applications on the issue of patentability, moreover, is consequent from the agency's unique expedient interpretation of the decision in *Brown* v. *Guild*, 90 U.S. 181, 210-211—an interpretation which the federal courts have not adopted. Pet. Question 2, p. 2; pp. 22-23.

The court of appeals misstated the constitutional issues raised by petitioner. It adjudicated their merits in the guise of pronouncing them insubstantial, without being able to cite even a semblance of a "prior decision" which "inescapably renders" any of them "frivolous".[3] This ad-

[3] Any suggestion of frivolity would be in the teeth of a long line of decisions by this Court, including *Black-Rock* and *Graham, supra,*

judication was pointedly without reference to the decisions of this Court in *Hagans* v. *Levine*, 415 U.S. 528 (1974) and *Goosby* v. *Osser*, 409 U.S. 512 (1973). A request for reconsideration, stressing the appellate court's noncompliance with the rules enunciated in *Goosby* . . . and *Hagans*, was summarily denied. See the petition, pp. 16a and 19a, and the discussion of the constitutional issues at pp. 14-18 and 22-28.

This ruling by the court of appeals conflicts directly with the decisions in *Goosby* and *Hagans*, both as enunciated and as applied. *Harris County Commissioner's Court* v. *Moore*, 43 U.S.L.W. 4223, 4224, n. 6 ;*Handle* v. *Sugarman*, No. 72-5758, 43 U.S.L.W. 3450; *Crow* v. *California Department of Human Resources*, No. 73-1015, 43 U.S.L.W. 3451.

CONCLUSION

The petition in this case must be granted. The decision should be *reversed* or the judgment vacated and the case remanded with instructions to appoint a three-judge court.

EDWARD S. IRONS
1801 K Street, N.W.
Washington, D. C.
Attorney for Petitioner

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which define the constitutional strictures on the issuance of patents. It would likewise contravene the court's recognition in *Brown* v. *Guild* that abandoned applications are part of the totality of evidence germane to patentability, especially when the latter is read with *Graham*, *Black-Rock*, and other cases of like purport.